

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-20 are presently active in this case.

In the outstanding Official Action, Claims 1, 2, 5-8, and 11-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo (U.S. Patent No. 5,943,954) in view of Schwöpfinger (U.S. Patent No. 5,320,042) and further in view of Marentes et al. (U.S. Patent No. 5,488,467). Claims 3, 4, 9, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo in view of Schwöpfinger and Marentes et al. and further in view of Kon (JP 58002146A). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness has not been established in the present case because there is no suggestion or motivation to modify or combine the references to arrive at the present invention.

Claim 1 of the present application recites a duplex stencil printer comprising, among other features, a cam member and a registration roller pair including a first roller disposed on

a lever and a second roller provided with a highly oil-repellent surface, where the second roller is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer. Claim 8 recites a duplex stencil printer comprising, among other features, a first roller of a registration roller pair is provided with a highly oil-repellent surface, and a second roller of the registration roller pair is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer. Claim 20 recites a duplex stencil printer comprising, among other features, first and second rollers to deliver the recording medium to a pressing member, where the second roller is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer.

The Official Action cites first drum (79) of the Otomo reference as the print drum of the present invention, second drum (80) as the pressing means, pick-up roller (25) as the feeding means, and registration roller pair (30) as the plurality of conveying members. The Official Action acknowledges that the Otomo reference does not disclose that one of the rollers of the registration roller pair (30) is provided with a highly oil-repellent surface or a with a surface configured to prevent adherence of the image to the roller, as is recited in the claims of the present application. The Official Action cites the Schwöpfinger reference for the teaching of a roller surface provided with an oil-repellent material or with a surface configured to prevent adherence of the image to the roller. However, one of ordinary skill in

the art would not have had a motivation to modify or replace a roller of the registration roller pair (30) of the Otomo reference with such roller as taught in the Schwöpfinger reference.

The Schwöpfinger reference clearly teaches a guide roller that is specifically intended to guide freshly printed paper web in order “[t]o provide a paper guide roller on which freshly printed ink does not smear....” (See, Title of the Invention, Abstract, Field of the Invention section in column 1, etc.) The guide roller has a very specialized construction that prevents or renders insignificant the deposit of ink on the surface thereof, yet avoids slippage between the roller and the paper. (See column 1, line 61, through column 2, line 2.) The construction of the roller described in the Schwöpfinger reference is much more complicated and labor intensive to manufacture than a typical guide roller, as it includes uniformly distributed glass beads provided in an ultra-high molecular plastic layer and applied with another layer to a base body using a thermal spray process, such as a flame spraying process. Due to the complexity and cost to produce such a complex roller configuration, such a roller would only be utilized in locations where they are necessary, such as in a situation where freshly printed surfaces of a paper web contacts the guide roller, as is taught throughout the Schwöpfinger reference. *However, one of ordinary skill in the art would not have been motivated to use the specialized guide roller of the Schwöpfinger reference as one of the rollers of the registration roller pair (30) of the Otomo reference as is suggested in the Official Action, since the registration roller pair (30) of the Otomo reference never contact freshly printed surfaces of a paper web.* Thus, the provision of a specialized guide roller as taught in the Schwöpfinger reference for one of the rollers of the registration roller pair (30) of the Otomo reference

would have been completely unnecessary and costly. In other words, the guide rollers of the Schwöpfinger reference are specifically designed for use in guiding freshly printed paper, therefore why would one of ordinary skill in the art be motivated to use such a roller at a location where the paper has not yet been printed on, absent the improper use of hindsight considerations?

The Otomo reference specifically states that “[i]t is therefore an object of the present invention to provide a stencil printer capable of producing a duplex printing of desirable quality in a single step....” (Column 1, line 66, through column 2, line 2.) Therefore, in the invention of the Otomo reference, the piece of paper only travels through the printer once. During that single trip through the printer, the first drum (79) is used to form an image on a first side of the paper and the second drum (80) is used to simultaneously form an image on a second side of the paper. Therefore, a wet image on the paper never contacts the registration roller pair (30), and thus there is no need to make a surface of either of the rollers of the registration roller pair (30) with an oil-repellent material or with a surface configured to prevent adherence of the image to the roller. The Otomo reference, in fact, opts for a more complex printer that includes two separate drums *specifically in order to avoid any potential for smearing of wet ink*. (See column 1, line 39, through column 1, line 63.)

The Official Action appears to suggest that since a sheet could be fed twice through the Otomo reference, then the guide roller of the Schwöpfinger reference could prove useful. However, the fact that a sheet *could be* fed twice through the Otomo reference is irrelevant to the discussion about motivation. The Otomo reference does not teach or even suggest

Application Serial No.: 10/765,137  
Reply to Office Action dated June 2, 2006

feeding a sheet through twice. And, in fact, the Otomo reference explicitly teaches a stencil printer capable of producing a duplex printing of desirable quality in a single step specifically *in order to avoid any potential for smearing of wet ink*. Thus, no motivation is present to make the proposed combination.

It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

Thus, the Applicants respectfully submit that a *prima facie* case of obviousness has not been established in the present case because there is no suggestion or motivation to combine the teaching of the Schwöpfinger reference with the Otomo reference and the Marentes et al. reference to arrive at the present invention in the manner set forth in the Official Action. The Official Action indicates that such a motivation was present since the Schwöpfinger reference indicates that the roller described therein can be easily cleaned, however this characterization of the ease of cleaning of the roller in the Schwöpfinger reference completely ignores that the contaminant being cleaned from the roller in the

Application Serial No.: 10/765,137  
Reply to Office Action dated June 2, 2006

Schwöpfinger reference is fresh ink, which is not an issue for the registration rollers (30) of the Otomo reference.

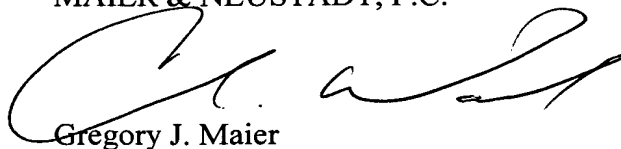
Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of independent Claims 1, 8, and 20.

The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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